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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,178	12/21/2001	Tung-Liang Li	PUSA211119	2786

7590 10/06/2004
Tung-Liang Li
58, MA YUAN WEST ST.
TAICHUNG,
TAIWAN

EXAMINER

SAIN, GAUTAM

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,178

Applicant(s)

LI, TUNG-LIANG

Examiner

Gautam Sain

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

- 1) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1-1) Claims 1 and 2 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 1, 2, the phrase "or the like" and "and the like" are vague and indefinite. Please correct to distinctly claim the subject matter.

Claim Rejections - 35 USC § 103

- 2) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2-1) Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassorla et al (US 5146552, issued Sept 1992).**

Regarding claim 1, Cassorla teaches electronic book, ... exist on the monitor individually (ie., annotating an electronic publication including books with notes, bookmarks and relate them to locations in the document. Annotations are stored separately and can be viewed simultaneously with document or separately)(col 2, lines 20-55)(Fig 6, items 24, 25 show two separate files – one for the book, one for the bookmark, ...).

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Cassorla does not teach 'dot bmk files' expressly. However it teaches book files that identifies topic, line number, author ... (ie., book files)(col 4, line 50; col 5, lines 8-30), where book file is equivalent to bookmark file. Bookmark files were commonly known at the time of the invention (see Bates, col 11, claim 8 as evidence). It would have been obvious to one of ordinary skill in the art that 'dot bmk' is merely the file extension for the bookmark file when saved in computer storage providing the purpose of a suggested standard file extension for storing bookmark/annotations data relating to documents (ie., help files, etc, ...) and associating annotation with electronically published material (Cassorla, Title).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cassorla to include a dot bmk file extension for the purpose of associating annotation with electronically published material/electronic book and saving the bookmark file (Cassorla, Title, Abstract, col 2, lines 5-15).

Regarding claim 2, Cassorla does not teaches "dot bmk file" but does teach book files that "contains a bookmark, underline, a highlight, a manual note, and the like" (ie., bookmark)(col 2, line 21)(ie., underlining, highlight)(col 8, line 23)(ie., manual note)(col 2, line 21)(ie., annotations)(col 2, lines 20-25). Bookmark files are equivalent to book files and were commonly known at the time of the invention (see rejection of claim 1 for support).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cassorla to include a dot bmk file extension for the purpose of

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associating annotation with electronically published material/electronic book and saving the bookmark file (Cassorla, Title, Abstract, col 2, lines 5-15).

Regarding claim 3, Cassorla teaches related data of ... arbitrarily (ie., edited or deleted)(col 9, lines 27-28)(ie., user can continue to add annotation)(col 9, line 54).

Regarding claim 4, Cassorla teaches executing a main program (ie., invention invoked by a reader ...)(col 3, lines 12 – 13).

Cassorla teaches reading out the original text file and the dot bmk file (ie., reader highlights area to create annotation on the electronic book)(col 3, lines 15-30)(book file)(col 4, line 50)(file ... relative to document)(col 5, line 21).

Cassorla teaches reading if the data file related to the book mark exists in the dot bmk file (ie., a book in progress ... read program identifies notes that pertain to that line)(col 5, lines 31-50).

Cassorla teaches reading in the data file related to the book mark (ie., the stored file of notes, bookmarks ... when the reader wants to review notes associated to a book)(col 5, lines 20-30; fig 6, item 24).

Cassorla teaches reading if the data file related to the underline exists in the dot bmk file (ie., the stored file of notes, bookmarks ... when the reader wants to review notes associated to a book)(col 5, lines 20-30; fig 6, item 24)(underlining is one of the notes that a reader can review as they are stored in the file along with other notes).

Cassorla teaches reading in the data file related to the underline (ie., the reader facilitates the reading of the underline from the stored file)(col 5, lines 20-30; fig 6, item 24, 25).

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Cassorla teaches reading if the data file related to the highlight exists in the dot bmk file (ie., the stored file of notes, bookmarks ... when the reader wants to review notes associated to a book)(col 5, lines 20-30; fig 6, item 24)(highlighting or adding marginal comments are notes that a reader can review as they are stored in the file along with other notes).

Cassorla teaches reading in the data file related to the highlight (ie., the reader facilitates the reading of the highlight from the stored file)(col 5, lines 20-30; fig 6, item 24, 25).

Cassorla teaches entering the reading mode (ie., read program displays a book file)(col 5, line 47).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 703-305-8777 **(after mid-October, 571-272-4096)**. The examiner can normally be reached on M-F 9-5 EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703)305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SANJIV SHAH
PRIMARY EXAMINER